

Confirmation No. 2154

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellant:	SIM	Examiner:	Doan, R.
Application No.:	10/521,701	Group Art Unit:	3732
Filed:	January 19, 2005	Docket No.:	SG020016US
Title:	HAIR COLORING DEVICE WITH DETACHABLY CONNECTED BASE PART		

APPEAL BRIEF UNDER 37 C.F.R. § 41.37

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Customer No. 24738

Dear Sir:

This Appeal Brief is submitted pursuant to 37 C.F.R. §41.37, in support of the Notice of Appeal filed November 20, 2007 and in response to the rejections of claims 1-10 as set forth in the Final Office Action dated August 20, 2007, and in further response to the Advisory Action dated October 17, 2007.

Please charge Deposit Account No. 14-1270 \$510.00 and all requisite fees/overages for filing this brief in support of an appeal as set forth in 37 C.F.R. §1.17(c).

I. Real Party In Interest

The real party in interest is Philips Electronics North America Corporation, having a principal place of business at 370 West Trimble Road, MS 91/MG, San Jose, California 95131. The above-referenced patent application is currently assigned to Koninklijke Philips Electronics N.V.

II. Related Appeals and Interferences

While Appellant is aware of other pending applications owned by the above-identified Assignee, Appellant is unaware of any related appeals, interferences or judicial proceedings that would have a bearing on the Board's decision in the instant appeal.

III. Status of Claims

Claims 1-10 stand rejected and are presented for appeal. A complete listing of the claims under appeal is provided in an Appendix to this Brief.

IV. Status of Amendments

As indicated in the Advisory Action dated October 17, 2007, the amendments to claim 2 and 8 in the Response to Final Office Action dated October 1, 2007 were entered. No other amendments have been filed subsequent to the Response to Final Office Action.

V. Summary of Claimed Subject Matter

Appellant's recited invention relates to an electrical device for applying a hair coloring additive to hair.

Commensurate with independent claim 1, an example embodiment of the present invention is directed to an electrical device for applying a hair coloring additive to hair (*see, e.g.*, device 2 shown in Figs. 1 and 2, and accompanying text), which device includes a container for hair coloring additive (*see, e.g.*, container 3 shown in Figs. 1, 2 and 3a-3c, and accompanying text), the container having a first side and a second side (*see, e.g.*, paragraph [0020]) and an additive displacing member provided in the vicinity of the second side (*see, e.g.*, additive displacing member 9 shown in Figs. 1, 3b and 3c, and accompanying text), the

first side being covered by a base part (*see, e.g.*, base part 6 shown in Figs. 1 and 2, base part 61 shown in Figs. 3a-3c, and accompanying text), the base part having a surface on which hair contacting elements and additive outlets are provided (*see, e.g.*, hair contacting elements 7 and 8 shown having additive outlets 7' and 8' as in Figs. 1 and 2, and accompanying text), the surface having a depression that surrounds said additive outlets (*see, e.g.*, depressions 12 and 12' shown in Figs. 3a-3c, and accompanying text), electrical actuator means (*see, e.g.*, electrical actuator means 10 shown in Fig 1, and accompanying text) for forcing said additive displacing member towards the base part for expelling additive from said container through said additive outlets (*see, e.g.*, paragraph [0020]), characterized in that the base part is in its entirety detachably connected to the container (*see, e.g.*, paragraph [0021]), and characterized in that the depression collects residual additive that is expelled through said additive outlets (*see, e.g.*, paragraph [0024]).

Commensurate with independent claim 2, an example embodiment of the present invention is directed to an electrical device for applying a hair coloring additive to hair that includes all the elements recited in claim 1, and that is further characterized in that the container is in its entirety detachably connected to the electrical device (*see, e.g.*, paragraph [0026]).

Commensurate with independent claim 8, an example embodiment of the present invention is directed to a container for use in an electrical device for applying a hair coloring additive to hair (*see, e.g.*, container 3 for use in device 2 as shown in Figs. 1, 2 and 3a-3c, along with accompanying text), the container including a first side (*see, e.g.*, first side 4 indicated in Fig. 1, along with accompanying text), the first side being covered by a base part (*see, e.g.*, base part 6 shown in Figs. 1 and 2, base part 61 shown in Figs. 3a-3c, and accompanying text) that has a surface on which hair contacting elements and additive outlets are provided (*see, e.g.*, hair contacting elements 7 and 8 shown having additive outlets 7' and 8' as in Figs. 1 and 2, and accompanying text), the surface having a depression that surrounds said additive outlets (*see, e.g.*, depressions 12 and 12' shown in Figs. 3a-3c, and accompanying text), the container also including a second side (*see, e.g.*, second side 5 indicated in Fig. 1, along with accompanying text) and an additive displacing member being provided in the vicinity of said second side (*see, e.g.*, additive displacing member 9 shown in

Figs. 1, 3b and 3c, and accompanying text), the additive displacing member for forcing said additive towards the base part to expel said additive from said container through said additive outlets (*see, e.g.*, paragraph [0020]), characterized in that the container is in its entirety detachably connectable to the electrical device (*see, e.g.*, paragraph [0026]), and characterized in that the depression collects residual additive that is expelled through said additive outlets (*see, e.g.*, paragraph [0024]).

As required by 37 C.F.R. § 41.37(c)(1)(v), a concise explanation of the subject matter defined in the independent claims involved in the appeal is provided herein. Appellant notes that representative subject matter is identified for these claims; however, the abundance of supporting subject matter in the application prohibits identifying all textual and diagrammatic references to each claimed recitation. Appellant thus submits that other application subject matter, which supports the claims but is not specifically identified above, may be found elsewhere in the application. Appellant further notes that this summary does not provide an exhaustive or exclusive view of the present subject matter, and Appellant refers to the appended claims and their legal equivalents for a complete statement of the invention.

VI. Grounds of Rejection to be Reviewed Upon Appeal

The only ground of rejection remaining to be reviewed on appeal is as follows:

- A. Claims 1-10 stand rejected under 35 U.S.C. § 103(a) over Mehringer *et al.* (U.S. 5,333,627) in view of Harlan *et al.* (U.S. 5,289,835) and Duqueroie (U.S. 2001/0042553).

Appellants note that the Advisory Action indicated that the rejection of claims 1-2, 6-8 and 10 under 35 U.S.C. § 103(a) over Lu (U.S. 2003/0131864) in view of Duqueroie (U.S. 2001/0042553) was overcome by the Response to Final Office Action.

VII. Argument

As set forth below, Appellant submits that the claimed invention is allowable over the cited references because the obviousness rejections are based on art that teaches away from, and that fails to provide correspondence to, the claimed invention. A purported obviousness rejection based on a combination of references fails unless the references are properly combinable and teach or suggest all the recited claim elements. Without a reasonable expectation of success and a valid reason for combining, references are not properly combinable. These conditions cannot be satisfied when a reference teaches away from the proposed combination or modification, or a reference is rendered inoperable for its intended purpose upon making the proposed combination or modification. Appellant submits that the Examiner's obviousness rejection fails to meet the require criteria, and therefore Appellant requests that the Board reverse.

A. The rejection of claims 1-10 under 35 U.S.C. § 103(a) over Mehringer in view of Harlan and Duqueroie should be reversed.

Appellant asserts that the § 103(a) rejection of claims 1-10 fails because the modification of Mehringer reference proposed by the Examiner defeats two stated purposes of Mehringer, and as such Mehringer teaches away from such a modification. According to M.P.E.P. § 2143.01, if a "proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984). The Examiner acknowledges that Mehringer does not teach or suggest the claim limitations directed to a depression that surrounds the additive outlets to collect residual additive. Furthermore, the Examiner fails to consider that the purposes of Mehringer's teachings are directly contrary to use of a dispenser head with a depression surrounding the additive outlets.

The Examiner proposes to combine Duqueroie's drip tray with Mehringer to collect excess product. However, the stated purposes of the Mehringer reference are to obtain an adequate distribution of products, while at the same time addressing various issues including

exposing as little product to air as possible (to delay oxidation and extend the useful life of the dyes), and avoiding application of the product to “those locks of hair that are intended to be excluded.” *See, e.g.*, Mehringer’s Col. 1:32-38 describing problems in the art compared to Mehringer’s Col. 2:4-17 describing the problems that are overcome. Appellant submits that the addition of a drip tray that collects excess product to Mehringer’s lower dispenser section (*see* dispenser section 9 in Mehringer’s Figures 1 and 4) would be understood by one of skill in the art to defeat the stated purposes of avoiding application of the dye to locks of hair intended to be excluded, and minimizing the amount of time that the product is exposed to air prior to application. For example, Appellant submits that a drip tray located to collect excess product around the application bristles of Mehringer’s dispenser would be expected to result in the collected excess product to be applied to locks of hair outside of the intended application area (*i.e.*, locks that are intended to be excluded). Moreover, Appellant submits that any product that collects in the proposed drip tray would be exposed to air for a period of time that would render the collected product unfit for use. Thus, this excess product should not be applied to the hair, which is what the proposed modification of Mehringer would result in as discussed above.

In the Advisory Action, the Examiner responded to Appellant’s previous arguments by stating that it is the brush, and not the “wide-mouthed container,” that would be the applicator in the proposed combination. Such a response fails to address the substance of Appellant’s arguments directed to how the inclusion of a drip tray would defeat Mehringer’s state purpose. Appellant’s arguments are not predicated on what part of the device should be considered as the applicator, but on how the proposed modification of Mehringer would result in a device that functions in a manner counter to the stated purposes of Mehringer. As such, there can be no motivation for one of skill in the art to make the required modifications, and the § 103(a) rejection of claims 1-10 based upon the Mehringer reference fails for inability to state a *prima facie* case of obviousness. Appellant therefore requests reversal of the rejection.

Appellant further asserts that the § 103(a) rejection of claims 2 and 8-10 fails due to lack of correspondence between the cited portions of the Mehringer, Harlan and Duqueroie references and the claimed invention. For example, the cited references fail to teach or suggest the claimed aspects directed to the container being detachable from the electric

device. The cited portions of the Mehringer reference do not teach that the container can be detached from the syringe. *See, e.g.*, container 3 and syringe 1 in Mehringer's Figure 4 along with Col. 3:35 to Col. 4:13. The cited portions of the Harlan reference also do not teach that the tube can be detached from the hair coloring brush depicted in Figure 5. *See, e.g.*, tube 20 in Harlan's Figure 5 along with Col. 4:22-24).

In the Advisory Action, the Examiner makes the contrary assertion that Harlan indeed shows that the brush 25 is detachably connected to container 20 at nozzle 26. Appellant submits that the Examiner's assertion is unsupported by any description in Harlan, and is impermissibly colored by the benefit of hindsight.

For these additional reasons, the § 103(a) rejection of claims 2 and 8-10 is improper for failure to find correspondence between the references and the recited claim elements. Appellant therefore requests reversal of the rejection.

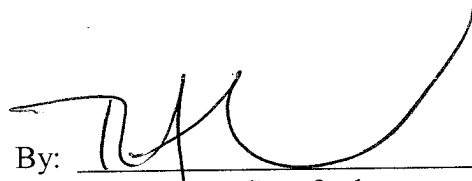
VIII. Conclusion

In view of the above, Appellant submits that the rejection of claims 1-10 is improper and therefore requests reversal of the rejections as applied to the appealed claims and allowance of the entire application.

Authority to charge the undersigned's deposit account was provided on the first page of this brief.

Please direct all correspondence to:

Philips Electronics North America Corp.
Intellectual Property & Standards
370 West Trimble Road, MS 91/MG
San Jose, CA 95131
(904) 333-9627

By: 
Name: Robert J. Crawford
Reg. No. 32,122
Paul Im, Reg. No.: 50,418
(SG020016US)

APPENDIX OF CLAIMS INVOLVED IN THE APPEAL
(S/N 10/521,701)

1. An electrical device for applying a hair coloring additive to hair, which device comprises:

a container for hair coloring additive, said container having a first side, a second side, and an additive displacing member being provided in the vicinity of said second side, said first side being covered by a base part having a surface on which hair contacting elements and additive outlets are provided, said surface having a depression that surrounds said additive outlets; and

electrical actuator means for forcing said additive displacing member towards the base part for expelling additive from said container through said additive outlets,

characterized in that the base part is in its entirety detachably connected to the container, and

characterized in that said depression collects residual additive that is expelled through said additive outlets.

2. An electrical device for applying a hair coloring additive to hair, which device comprises:

a container for hair coloring additive, said container having a first side, a second side, and an additive displacing member being provided in the vicinity of said second side, said first side being covered by a base part having a surface on which hair contacting elements and additive outlets are provided, said surface having a depression that surrounds said additive outlets; and

electrical actuator means for forcing said additive displacing member towards the base part for expelling additive from said container through said additive outlets,

characterized in that the base part is in its entirety detachably connected to the container, and

characterized in that said depression collects residual additive that is expelled through said additive outlets, and

characterized in that the container is in its entirety detachably connected to the electrical device.

3. A device as claimed in Claim 1, characterized in that the device comprises at least one further base part which comprises further hair contacting elements and is in its entirety detachably connected to the device.
4. A device as claimed in Claim 1, characterized in that the hair contacting elements comprise hollow pins each provided with an additive outlet.
5. A device as claimed in Claim 3, characterized in that the further hair contacting elements comprise brush hairs.
6. A device as claimed in Claim 3, characterized in that a surface of the at least one further base part, on which the further hair contacting elements are provided, comprises a depression.
7. A device as claimed in Claim 6, characterized in that said depression is provided in the vicinity of the further hair contacting elements.
8. A container for use in an electrical device for applying a hair coloring additive to hair, said container comprising:
 - a first side, said first side being covered by a base part having a surface on which hair contacting elements and additive outlets are provided, said surface having a depression that surrounds said additive outlets;
 - a second side; and
 - an additive displacing member being provided in the vicinity of said second side, said additive displacing member for forcing said additive towards the base part to expel said additive from said container through said additive outlets; and

characterized in that the container is in its entirety detachably connectable to the electrical device, and

characterized in that said depression collects residual additive that is expelled through said additive outlets.

9. A container for use in an electrical device for applying a hair coloring additive to hair as claimed in claim 8, characterized in that the base part forms a part of the container and is in its entirety detachably connected to the container.

10. A container for use in an electrical device for applying a hair coloring additive to hair as claimed in claim 8, characterized in that a surface of the base part, on which the hair contacting elements are provided, comprises a depression.

APPENDIX OF EVIDENCE

Appellant is unaware of any evidence submitted in this application pursuant to 37 C.F.R. §§ 1.130, 1.131, and 1.132.

APPENDIX OF RELATED PROCEEDINGS

As stated in Section II above, Appellant is unaware of any related appeals, interferences or judicial proceedings.